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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,239	02/05/2007	Avidor Shulman	7056-X08-022	9066
27317 7590 07/15/2009 Fleit Gibbons Gutman Bongini & Bianco PL 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI, FL 33180				
EXAMINER				
MERCIER, MELISSA S				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
07/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/576,239

**Applicant(s)**

SHULMAN ET AL.

**Examiner**

MELISSA S. MERCIER

**Art Unit**

1615

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-24, 26-30 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25, 31-34 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 12-15-06, 5-28-08, 11-10-08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Change of Examiner***

The examiner assigned to the instant application has changed. The new examiner is Melissa Mercier. Contact information is provided at the end of this Office Action.

### ***Election/Restrictions***

Applicant's election with traverse of Group II in the reply filed on May 13, 2009 is acknowledged. The traversal is on the ground(s) that the method claims are obvious variants of each other and that the methods all accomplish the same goal, enhancement of dietary mineral absorption in order to provide the claimed effects such as enhanced energy, treatment of disease, enhanced bone formations. Applicant further argues that the enhancement of dietary mineral absorption should be considered a novel technical feature. This is not found persuasive because Applicant has amended claim 25 to recite a materially different lipid than is now recited in the other claims. Applicant is further reminded that the special technical feature must be shared among all claims within the Application and be considered novel. This is not the case with the instant application, since the particular lipid recited is known, as evidenced in the lack of unity dated March 16, 2009.

Regarding the election of species requirement, it is also unclear to the Examiner if Applicant is arguing that it is improper because they are obvious variants of each

other and also functional equivalents. Applicant is requested to state such on the record if that is the reasons for traversal.

The requirement is still deemed proper and is therefore made FINAL.

Claims 13-24, 26-30, and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups, there being no allowable generic or linking claim.

### ***Priority***

Applicant's claim of priority as a 371 of PCT/IL04/00961 filed on October 21, 2004 is acknowledged.

### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statements filed on December 15, 2006, May 28, 2008, and November 10, 2008 is acknowledged. Signed copies are attached to this office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25, 31-34 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25 recites "oils mimicking the triglyceride composition of human are mother's milk fat, or a food article comprising the same". However, Applicant has not provided adequate written description for what types of oils would meet the claimed functional property. Applicant has identified two commercially available products as examples of lipids which would meet the claimed functional property. However, one of them appears to be the already claimed "glyceride-based lipid with over 50% of mono or poly unsaturated fatty acids and a high level of palmitic acid. Applicant has only disclosed the functional properties of what kinds of lipids may fall within the class; therefore such a disclosure would result in one of ordinary skill performing hit or miss testing in order to determine what kinds of lipids would fall within the claimed genus.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25, 31-34, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, for example, claim 25 recites the broad recitation chemically or enzymatically synthesized synthetic oils, and the claim also recites particularly glyceride-based lipids which is the narrower statement of the range/limitation. It is noted that numerous instances of this occur type of recitation appear within the claim. Appropriate correction is needed.

Regarding claim 32, the phrase "including" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). It is unclear if the claim is limited to the terms following "including".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 31-34, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kennedy et al. (Double blind, randomized trial of a synthetic triacylglycerol in formula fed term infants: effects on stool biochemistry, stool characteristics, and bone mineralization).

An infant formula comprising triacylglycerols with high sn-2 palmitate on the glycerol backbone and calcium, among other vitamins, was administered to term infants and showed an increase in calcium absorption and greater skeletal mineral deposition. The formula further comprised proteins, carbohydrates, and vitamins which are considered to be edible additives, thereby meeting the limitation of claim 31.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615